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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/938,454      | 08/24/2001  | Carol J. Collins     | NEU-40              | 2232             |

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EXAMINER

SHEIKH, HUMERA N

ART UNIT PAPER NUMBER

1615

DATE MAILED: 02/12/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/938,454

Applicant(s)

COLLINS ET AL.

Examiner

Humera N Sheikh

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Acknowledgement is made of the Declaration file 01/08/02.

#### ***Claim Objections***

Claims 4, 8, 12, 16, 20 and 24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of claims 4, 8 and 12 of polyurethane, cyclomethicone, polysilicone-I1 and claims 16, 20 and 24 wherein said mascara does not comprise wax, fail to further limit the subject matter because these limitations were already claimed in the previous claims.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-4, 13 and 15-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Brieva et al. (US Pat. No. 6,214,329 B1).

Art Unit: 1615

Brieva et al. clearly disclose a mascara composition comprising non-wax gelling agents, an organopolysiloxane elastomer and silicone oil, wherein the mascara contains reduced levels of wax, or no wax at all (see reference column 1, lines 10-60); (column 2, lines 14-50); (column 5, lines 15-42); (column 6, lines 6-44); (column 8, lines 58-67); (column 9, lines 8-15); (column 12, lines 31-40); (column 16, lines 43-50); (column 17, lines 3-8) and see examples.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brieva et al. (US Pat. No. 6,214,329 B1).

Brieva et al. explicitly teaches the use of a mascara comprising an organosiloxane elastomer and silicone oil, wherein the mascara contains less than about 1%, by weight of wax (see reference column 5, lines 15-18, 39-42); (column 6, lines 6-44); (claims 8 & 9). Suitable particulates, such as mica, can be added to the mascara composition (column 9, line 8), as well as polyurethane (column 12, lines 31-35); (Examples 1 & 3). In addition, there is teaching of the desire to formulate mascaras that contain reduced levels of wax, or no wax at all (column 1, lines 30-35) and further objectives of providing a viscous mascara with non-wax gelling agents (column 1, lines

Art Unit: 1615

47-50) and a mascara composition that contains minimal amounts of animal, vegetable, or mineral waxes, or where such waxes are not present at all (column 1, lines 53-56). Therefore, it would have been obvious to one of ordinary skill in the cosmetic art at the time the invention was made to use the teachings of Brieva et al. to provide formulations with reduced levels of wax content, or no wax at all in combination with gelling agents, organosiloxane elastomers and silicone oils. The expected result would be a long-lasting mascara formulation that provides improved coloring, lengthening, thickening and curling of eyelashes.

Regarding claims 9-12, which identifies a particular polysiloxane elastomer, there is no criticality seen since the formulation suggested by Brieva et al. provides for the same beneficial effects of the mascara as those desired by the Applicant. The burden is shifted to the Applicant to demonstrate some degree of criticality in utilizing polysilicone-11.

Prior Art made of record and deemed relevant by the Examiner:

US Patent No. 5,985,298 (10-1998) Brieva et al.

US Patent No. 5,266,321 (03-1992) Shukuzaki et al.

US Patent No. 6,027,738 (10-1997) Stepniewski et al.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera Sheikh whose telephone number is (703) 308-

Art Unit: 1615

4429. The examiner can normally be reached on Monday through Friday from 7:00A.M. to 4:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
THURMAN R. PAGE  
SUPERVISORY PATENT EXAMINER  
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